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IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Cali St.John Group Art Unit: 1733
Serial No.: 09/637,242 Examiner: Jessica L. Rossi
Title: BUSINESS METHOD FOR INDICIA WITH SANITARY BEVERAGE CAN
Filing Date: August 14, 2000
Attorney Docket No.: 946-5

**APPELLANT'S CORRECTED
APPEAL BRIEF**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant in compliance with 37 C.F.R. § 41.47 and MPEP § 1205.02 herewith submits this Corrected Appeal Brief concerning the foregoing application. An Appeal Brief (hereinafter referred to as the "Original Appeal Brief" was filed September 23, 2005 and was the subject of a PTOL-462 Notification of Non-Compliant Appeal

Brief (37 CFR 41.37) to which the present Corrected Appeal Brief responds.

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C. Real Party in Interest

The real party in interest in this appeal is above identified Applicant, Cali St.John.

D. Related Appeals and Interferences

There are no other appeals or interferences.

E. Status of Claims

All presently pending claims, namely claims 1-19, stand finally rejected based upon the cited prior art under 35 U.S.C. § 103. The Board is respectfully requested to note that an Amendment Before Appeal was filed concurrently with the Original Appeal Brief, filed September 23, 2005, to address claim objections, 35 USC § 112 rejections, and a provisional double patenting rejection, such that all pending 19 claims are intended to be similarly situated as finally rejected under 35 U.S.C. § 103. The claims being appealed are claims 1-19. The content of these claims are set forth in the Claims Appendix to this Brief in accordance with 37 C.F.R. § 41.37(c)(iii).

F. Status of Amendments

There was one Amendment filed subsequent to the final rejection mailed on October 6, 2004 as described above. It was filed September 23, 2005, and accompanied the Original Appeal Brief. This Amendment was not directed to the prior art rejections to be addressed in this Appeal. Rather it was expected to satisfy the Examiner's requirements with regard to claim objections, 35 U.S.C. § 112 rejections, and double patenting rejections. This Amendment is not believed to have been acted upon by the Examiner, but so far as is known has not been refused entry either. Since it does not deal with prior art rejections, and is intended to be compliant with the Examiner's suggestions concerning claims objections, Section 112 rejections, and provisional double patenting rejections, refusal of entry is not expected.

G. Summary of Claimed Subject Matter

As an overview the present invention is a business method as defined in the independent claims involved in this Appeal, claims 1, 16, and 17. The independent claims feature a protective member 24 (page 15, line 7 et seq.) for application to a beverage container 10 (page 14, line 21 et seq.) so the beverage container 10 will be clean for use in consuming the beverage directly from the container 10 (page 1, lines 18-25, page 12, lines 10-16). These protective members are manufactured by a protective member manufacturer who also conveys by profit making sale to third party advertisers a right to attach indicia including advertising to protective members which are adhered to beverage containers (page 13, lines 2-9, page 1, lines 12-13). Four parties are involved, namely the protective member manufacturer, the third party advertisers, the beverage company and consumers. (page 13, lines 5-8). The invention is a method of doing business application concerning the protective member manufacturer. (page 13, lines 2-9).

More specifically, claim 1 recites:

A business method for a protective member manufacturer relating to beverage containers 10 comprising:

the protective member manufacturer conveying by profit making sale to third party advertisers (page 7, line 22 to page 8, line 1) a right to attach indicia 36 to consumer

removed, flexible (page 17, line 21)
protective members 24 to be adhered to
beverage containers 10;

manufacturing the protective members 24
(page 13, lines 7-8);

applying indicia 36 to the protective
members 24 (page 16, lines 17-18); and

adhering the protective members 24 to the
containers 10 to form a substantially wrinkle
free (page 10, line 21) skin tight (page 10,
line 17) seal between the protective member 24
and at least a portion of a mouth contact area
26 of the beverage containers 10.

Turning now to independent claim 16, it recites:

A business method for a protective member
manufacturer relating to beverage containers
comprising:

the protective member manufacturer
conveying to a third party advertiser by
profit making sale (page 7, line 22 to page 8,
line 1) a right to attach indicia 36 to
consumer removed, flexible (page 17, line 21)
protective members 24 to be adhered to a
beverage container 10;

manufacturing each protective member in

an hourglass configuration (page 16, line 2) to facilitate adherence to a top 12 and convex (page 16, lines 25-26) side 14 of a container 16 without deformation (page 10, line 6) and without wrinkling (page 16, line 4) of a material of each protective member 24;

applying indicia to each protective member (page 16, lines 17-18); and

adhering each protective member 24 to a container 10 including by folding each over a rim of (page 16, line 3) a beverage container 10 to form a substantially wrinkle free (page 16, line 4) skin tight (page 15, line 26) seal between the protective member 24 and at least a portion of a mouth contact area 26 of the beverage containers 10.

The final independent claim is claim 17, which recites:

A business method for a protective member manufacturer relating to beverage containers comprising:

the protective member manufacturer conveying by profit making sale to a third party advertiser (page 17, lines 8-17), a right to attach indicia 36 to consumer removed, flexible (page 17, line 21) protective members 24 to be adhered to

beverage containers 10;

manufacturing the protective members 24
(page 13, lines 7-8);

applying indicia to opaque protective
members 10 by printing on the underside
thereof (page 12, lines 18-22) to facilitate
using the method for such things as games of
chance, premiums, collectibles, redeemables,
merchandise acquisition means, and prizes
(page 1, lines 13-17) without a user knowing
in advance of protective member removal which
of a plurality of chances the user has
obtained (page 12, lines 17-26); and

adhering the protective members 24 to the
containers 10 to form a substantially wrinkle
free (page 16, line 4) skin tight (page 15,
line 26) seal between the protective member 10
and at least a portion of a mouth contact area
26 of the beverage containers 10.

H. Grounds of Rejection to be Reviewed on Appeal

All the rejections being appealed are prior art rejections that are based on 35 U.S.C. § 103 for obviousness. In addition, all these rejections are based on combinations of more than one reference.

The references relied upon by the Examiner in rejecting all nineteen (19) pending claims are as follows: Kinoian, et al., U.S. Patent No. 3,690,509, Bozlee, U.S. Patent No. 6,354,645, an English translation of Kagami in Japanese reference JP 6-171650, Burns, U.S. Patent No. 6,127,437, Ruemer, U.S. Patent No. 4,402,421, Takayama, U.S. Patent No. 6,015,059, Dronzek, U.S. Patent No. 5,925,208, Sommers, U.S. Patent No. 6,620,281 and Miyazaki, et al., U.S. Patent No. 5,863,624.

The Examiner rejected claims 1-2, 4-5 and 12 on the combination of the references Kinoian, et al. and Bozlee. The Examiner has rejected claims 3, 6, 9-10, and 16 based on the combination of the references Kinoian, et al., Bozlee and Kagami. The Examiner has rejected claims 11, 17, and 19 based on the combination of the references Kinoian, et al., Bozlee, Kagami and Ruemer. Other claim rejections are of various dependent claims and are not going to be recited or argued, since the allowability of dependent claims may be based on the independent claims from which they depend.

Therefore the claim groupings to be presented to the Board and argued as a group are as mandated by the groupings selected by the Examiner in her rejections. These claim groupings will be

presented as headings in the argument following in accordance with 37 C.F.R. § 41.37(c)(vii). They are as follows:

- (1) Claims 1, 4-5, 7-8, and 12
- (2) Claims 3, 6, 9-10 and 16
- (3) Claims 11, 17, and 19

I. Argument

The legal issues to be presented to the Board have to do with well established principles of patent law including the use of hindsight in combining references, the use of nonanalogous art as a citation in claiming obviousness, the combination of references where there is no suggestion in the art to combine, and the modification of a reference by the Examiner also known as citing a reference for more than what it teaches.

(1) Claims 1, 4-5, 7-8, and 12

The Examiner rejected claims 1-2, 4-5 and 12 on the combination of the references Kinoian, et al. and Bozlee. The rejection is improper for at least three (3) legal reasons described above. Specifically, those three (3) reasons are the use of hindsight in combining references, the use of nonanalogous art as a citation in claiming obviousness, and the combination of references where there is no suggestion in the art to combine.

The first one is that it is only possible to make the combination of these two references through the use of hindsight. The notion that one can not use hindsight in combining references is quite old in patent law. *Loam Co. v. Higgins*, 105 U.S. 580 (1882). Hindsight is now well established to be impermissible to piece together references for obviousness rejections. *In re Warner and Warner*, 154 U.S.P.Q. 173, 178 (C.C.P.A. 1967), cert. denied, 389 U.S. 1057 (1968); *Ex parte Haymond*, 41 U.S.P.Q.2d 1217, 1219-1220 (Bd. App. 1996); MPEP 2143.01, *Ex parte Levengood*, 28

U.S.P.Q.2d 1300 (Bd. App. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318, (Fed. Cir. 2000). The reason that it constitutes hindsight is because the reference Bozlee is nonanalogous art, since it teaches carrying bags with handles which can include advertising. The present invention deals with protective members applied to beverage containers such as cans. There is no reason to look to the bag handle art.

Put another way, there must be a suggestion in the art to combine references. *Uniroyal v. Rudkin-Wiley Corp.*, 5 U.S.P.Q.2d 1434, 1439 (Fed. Cir. 1988); *Ex parte Dussaud*, 7 U.S.P.Q.2d 1818, 1820 (Bd. App. 1988). The mere fact that references can be combined is insufficient. MPEP 2143.01; *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); *Litton Systems, Inc. v. Honeywell, Inc.*, 39 U.S.P.Q.2d 1321, 1327 (Fed. Cir. 1996); *SmithKline Diagnostics, Inc. v. Helena Labs Corp.*, 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988).

Rejections of claims 1-2, 4-5 and 12 based on Kinoian, et al. and Bozlee is also improper because neither reference teaches a substantially wrinkle free skin tight seal between the protective member and at least a portion of the mouth contact area of the container. The Examiner points to column 3, lines 10-25 and column 4, lines 24-25 of Kinoian, et al., but examination thereof shows no reference whatsoever to a substantially wrinkle free skin tight seal between the protective member and the container. The wrinkle free skin tight seal is an important feature of the present invention recited in claim 1 because it is necessary to prevent

contamination from getting under any portion of the protective member where it can come in contact with the container surface.

It is well established that a reference only stands for what it actually discloses. *In re Gordon, et al.*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984); *Carl Schenck, A.G. v. Nortron Corp.*, 218 U.S.P.Q.2d 698, 702 (Fed. Cir. 1983); *In re Imperato*, 179 U.S.P.Q. 730, 732 (C.C.P.A. 1973). Put another way, modification of a reference unwarranted by the disclosure thereof is improper. *Carl Schenck, A.G. v. Nortron Corp.*, *supra*.

(2) Claims 3, 6, 9-10 and 16

The Examiner has rejected claims 3, 6, 9-10, and 16 based on the combination of the references Kinoian, et al., Bozlee and Kagami. Claim 3 and claim 16 include the limitation of manufacturing the protective member in an hourglass configuration. Bozlee is nonanalogous art, Kinoian, et al. is conceded by the Examiner to be silent on an hourglass configuration, and then Examiner asserts that Kagami teaches an hourglass configuration for the protective member. But examination of Kagami reveals that it is silent on an hourglass configuration to facilitate adherence to a top and convex side of a container without deformation, without heat shrink application, and without wrinkling of a material protective member. Modification unwarranted by the disclosure in a reference is improper as set forth previously herein. *Carl Schenck, A.G. v. Nortron Corp.*, *supra*. A reference only stands for what it actually discloses. *In re Gordon, et al.*, *supra*; *In re*

Imperato, supra.

(3) Claims 11, 17, and 19

Finally, the Board's attention is respectfully directed to claims 11, 17, and 19. Claims 11 and 17 includes the limitations that the protective member facilitates using the method for such things as games of chance, premiums, collectibles, redeemables, merchandise acquisition means, and prizes without a user knowing in advance of the protective member removal which of a plurality of chances the user has obtained. The Examiner has rejected claims 11 17 and 19 on the combination of the references to Kinoian, et al., Bozlee, Kagami and Ruemer. The Examiner further concedes Kinoian, et al. is silent as to the foregoing limitations and points to Ruemer, column 2, lines 23-25 and 49-51. In fact, Ruemer discloses only redeemable prizes. No reference discloses games of chance, premiums, collectibles, and redeemables.

In claim 17 indicia on the protective member includes the purposes of advertising, games of chance, premiums, collectibles, redeemables, merchandise acquisition means, and prizes without the user knowing in advance of protective member removal which of a plurality of chances the user has obtained. However the Examiner also points out that Kinoian, et al. teaches that the indicia can be advertising or instructions referencing column 3, lines 29 and 30. That is true. But that means there is no reference teaching games of chance, public service announcements, and warnings. Once again a reference only stands for what it actually discloses. *In*

re Gordon, et al., supra; Carl Schenck, A.G. v. Nortron Corp., supra; In re Imperato, supra. Modification unwarranted by the disclosure of references is improper. In re Randol and Redford, 165 U.S.P.Q. 586 (C.C.P.A. 1970); National Tractor Pullers Assn., Inc. v. Watkins, 205 U.S.P.Q. 892, 911; In re Irani and Moedritzer, 166 U.S.P.Q. 24. (C.C.P.A. 1970).

Argument Conclusion

The present invention is not only a method of doing business application, it also recognizes the formation of a new business entity referred to as the protective member manufacturer. The beverage container protective member prior art as shown in the references cited by the Examiner includes only three (3) entities, namely, the beverage company, third party advertisers, and the consumer. The Examiner has not located in the five years that this application has been pending any reference in the beverage container protective member art which teaches the establishment of a new business that combines protective sanitized beverage cans from contamination and third party paid advertising with a new business entity that ties together both features into a money making enterprise in the form of a new business. That is why the Examiner has cited Bozlee, but Bozlee is not in the beverage container protective member art. There is no suggestion that one skilled in the art should look to the bag handle art to find the creation of a new entity. It takes the existence of a new entity to drive the business of combining these features into a profit making enterprise. Bozlee is a bag handle patent that happens to

have advertising but it has only one line in the patent that speaks to the notion of making money from the advertisers and it is simply nonanalogous art. Under the circumstances, independent claims 1, 16 and 17 should certainly be allowable.

In addition thereto, claim 17 further recites opaque protective members by printing on the underside thereof to facilitate using the method for such things as games of chance, premiums, collectibles, redeemables, merchandise acquisition means, and prizes without a user knowing in advance of protective member removal which of a plurality of chances the user has obtained. That feature is not taught in its entirety by any reference of record.

Finally, claim 16 further recites the use of an hourglass configuration to facilitate adherence of the protective member to the top and convex side of a beverage container, and no reference teaches or suggests that. The Examiner has improperly modified references beyond what they teach to reject the hourglass configuration.

Accordingly, reversal of the Examiner is respectfully requested.

J. Claims Appendix

What is claimed is:

1. A business method for a protective member manufacturer relating to beverage containers comprising:

the protective member manufacturer conveying by profit making sale to third party advertisers a right to attach indicia to consumer removed, flexible protective members to be adhered to beverage containers;

manufacturing the protective members;

applying indicia to the protective members; and

adhering the protective members to the containers to form a substantially wrinkle free skin tight seal between the protective member and at least a portion of a mouth contact area of the beverage containers.

2. The method of claim 1 in which third party advertisers are not a beverage company.

3. The method of claim 1 which further comprises:

manufacturing the protective members in an hourglass configuration to facilitate adherence to a top and convex side of a container without deformation and without wrinkling of a material of the protective member by folding it over a rim of the beverage container such that when adherence occurs there is facilitated the substantially wrinkle free skin tight seal between the protective member and at least a portion of a

mouth contact area of the beverage container.

4. The method of claim 1 which further comprises sanitizing at least the mouth contact portion of the containers.

5. The method of claim 1 in which the indicia is at least one of advertising, promotion, games of chance, premiums, collectibles, redeemables, merchandise acquisition means, prizes, public service announcements, instructional information, and warnings.

6. The method of claim 1 wherein indicia is applied to the protective members by printing.

7. The method of claim 6 which further comprises treatment of the protective members to accept and retain printing ink.

8. The method of claim 7 in which the treatment of the protective members is by corona discharge.

9. The method of claim 6 wherein the printing is applied to an underside of the protective members.

10. The method of claim 9 where the protective member is opaque so that the user cannot see the indicia until the protective member is removed.

11. The method of claim 10 where the underside printing and opaque protective member facilitates using the method for such things as games of chance, premiums, collectibles, redeemables, merchandise acquisition means, and prizes without a user knowing in advance of protective member removal which of a plurality of chances the user has obtained.

12. The method of claim 1 wherein the protective members are adhered to containers using adhesive.

13. The method of claim 12 in which the adhesive is antibacterial.

14. The method of claim 1 which further comprises imposing an anti-static chemical treatment on the protective member such that each one of the protective members will slide easily from an adjoining member and not cling to it under high speed dispensing.

15. The method of claim 1 which further comprises imposing chemical treatment on the protective member such that adhesive will bond more strongly to the member and less strongly to metal of the beverage container such that no adhesive residue is left on the container after removal of the protective member thus allowing the protective member to be adhered to other surfaces.

16. A business method for a protective member manufacturer

relating to beverage containers comprising:

the protective member manufacturer conveying to a third party advertiser by profit making sale a right to attach indicia to consumer removed, flexible protective members to be adhered to a beverage container;

manufacturing each protective member in an hourglass configuration to facilitate adherence to a top and convex side of a container without deformation and without wrinkling of a material of each protective member;

applying indicia to each protective member; and

adhering each protective member to a container including by folding each over a rim of a beverage container to form a substantially wrinkle free skin tight seal between the protective member and at least a portion of a mouth contact area of the beverage containers.

17. A business method for a protective member manufacturer relating to beverage containers comprising:

the protective member manufacturer conveying by profit making sale to a third party advertiser, a right to attach indicia to consumer removed, flexible protective members to be adhered to beverage containers;

manufacturing the protective members;

applying indicia to opaque protective members by printing on the underside thereof to facilitate using the method for such things as games of chance, premiums, collectibles,

redeemables, merchandise acquisition means, and prizes without a user knowing in advance of protective member removal which of a plurality of chances the user has obtained; and

adhering the protective members to the containers to form a substantially wrinkle free skin tight seal between the protective member and at least a portion of a mouth contact area of the beverage containers.

18. The method of claim 1, wherein the protective members when at least partially removed from the beverage containers are reattachable thereto.

19. The method of claim 1, wherein the protective members are collectible.

K. Evidence Appendix

There is no evidence in the form of affidavits, declarations or other publications that are relevant to this appeal.

L. Related Proceedings Appendix

There are no related proceedings.

CERTIFICATE OF MAILING

I HEREBY CERTIFY that the foregoing paper has been deposited **November 21, 2005**, with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, which is a date prior to the expiration of the set period, as extended if necessary by the due date falling on a Sunday, and I therefore assert timely filing of the foregoing paper in accordance with 37 C.F.R. § 1.8.

Respectfully submitted,

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